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In re Reissue Application of
Richard J. Morris et al.
Application No. 10/805,686 ✓
Filed: March 19, 2004
For: U.S. Patent No. 6,357,193

In re Richard J. Morris, et al.
Reexamination Proceeding
Control No. 90/007,487
Filed: March 29, 2005
For: U.S. Patent No. 6,357,193

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: DECISION, *SUA SPONTE*,
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS
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REEXAM UNIT

The above reissue and reexamination proceedings are before the
Office of Patent Legal Administration for *sua sponte*
consideration of whether the proceedings should be merged under
37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. patent No. 6,357,193 issued on March 19, 2002, with 22 claims.
2. An application for reissue, assigned application No. 10/805,686, was filed by the patent owner on March 19, 2004.
3. The filing of the '686 reissue application was announced in the *Official Gazette* on November 23, 2004.
4. A request for reexamination was filed by a third party requester on March 29, 2005, and was assigned control No. 90/007,487 (hereinafter, the '7487 proceeding).
5. Reexamination was ordered for the '7487 reexamination proceeding on June 2, 2005.
6. An information disclosure statement under 37 CFR 1.555 was filed in the '7487 proceeding by the patent owner on June 9, 2005.¹
7. A patent owner's statement under 37 CFR 1.530 was not received in the '7487 proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

"If a reissue application and an ex parte reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 10/805,686 and reexamination control No. 90/007,487 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

¹On June 15, 2005, a certificate of service certifying that copies of all papers filed with the Office on June 9, 2005, were served on the third party requester, was received by the Office.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In order to provide efficient and prompt handling of the reissue and reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the instant reissue and reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an ex parte reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. The present merger is not an assurance that, in a future similar situation, merger would be ordered.

**DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS**

I. Merger of Proceedings

The above-noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue application and the reexamination proceeding for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings

remain merged. See 37 CFR 1.565(d).

2. A review of the file for reexamination control No. 90/007,487 shows that original patent claims 1-22 are present. A review of reissue application No. 10/805,686 shows that original patent claims 4, 5, 7, 10-13 and 21 are present, patent claims 1, 14-20 and 22 are canceled, and patent claims 2, 3, 6, 8, and 9 are amended. In addition, new claims 23-25 have been added. **Accordingly, the claims are not identical in both proceedings.**

An appropriate housekeeping amendment (in one or both cases) is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, Application No. 10/805,686 and Control Number 90/007,487. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must **not address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged reexamination/reissue proceeding are submitted in accordance with the reissue practice under 37 CFR 1.173.**

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.
2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.
3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner

will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases, i.e., the reissue application and the reexamination proceeding*, and each action will be entered into both files (which will be maintained as separate files).
5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. Any such response must contain identifying data *for both of the cases, i.e., the reissue application and the reexamination proceeding*. Any such responses must be served on the requester, who will also be sent copies of Office actions.
6. Pursuant to MPEP 2285:

"Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the

date of filing the reissue application. Amendments are not to be made relative to previous amendments. Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appeal brief, even though the brief relates to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file in the merged proceeding.
8. Upon return of the present merged proceeding to the examiner, the examiner (a) will review the files to ensure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.
9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.
10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues

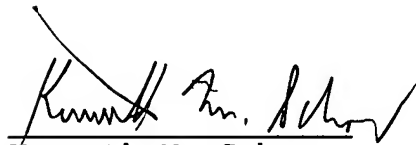
remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper for consideration in reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 10/805,686 and reexamination control No. 90/007,487 are merged into a single proceeding.
2. Pursuant to Part II of this decision, it is required that applicant/patent owner file, **within ONE MONTH of this decision**, a housekeeping amendment placing the same amendments in both cases of the present merged proceeding.
3. Because the reexamination request is granted and the reissue and reexamination proceedings are merged, the merged proceeding will be handled by the examiner assigned to the reexamination proceeding, pursuant to MPEP 2236. Accordingly, the reissue and reexamination proceedings are being forwarded to the examiner via the Director of Technology Center 2800. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.
4. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

5. Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Legal Advisor, at (571) 272-7724.

A handwritten signature in black ink, appearing to read "Kenneth M. Schor", is written over a horizontal line.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

07/13/2005